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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/587,574 06/05/00 BEHRENS

J 0107-026P

023622  
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NEW YORK NY 10017

HM12/0702

EXAMINER
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DAVIS, N

ART UNIT	PAPER NUMBER
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1642

DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.

09/587,574

Applicant(s)

BEHRENS ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-21 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**\*DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a material for the diagnosis of tumors, classified in class 536, subclass 23.1.
  - II. Claims 6-9, drawn to a material for the treatment of tumors, classified in class 530, subclass 350 or 387.1.
  - III. Claims 10-14, drawn to a conductive amino acid sequence of SEQ ID NO: 1, classified in class 530, subclass 350.
  - IV. Claim 15, drawn to the partial sequence of Adenomatosis Poliposis Coli, classified in class 530, subclass 350.
  - V. Claims 16-20, drawn to a conductive cDNA sequence of SEQ ID NO: 6, classified in class 536, subclass 23.1.
  - VI. Claim 21, drawn to the use of conductive for gene therapy, classified in class 514, subclass 44.
  
2. A. In the event applicant elects Group III, claims 10-14, applicant is required to elect a single species of conductive, comprising:
  - Species A, drawn to SEQ ID NO: 1
  - Species B, drawn to SEQ ID NO: 2
  - Species C, drawn to SEQ ID NO: 3
  - Species D, drawn to SEQ ID NO: 4
  - Species E, drawn to SEQ ID NO: 5

Species A-E are patentably distinct based on structural and functional differences and mode of action, as species may target different receptors.

B. In the event applicant elects Group V, claims 16-20, applicant is required to elect a single species of conductine, comprising:

Species F, drawn to SEQ ID NO: 6

Species G, drawn to SEQ ID NO: 7

Species H, drawn to SEQ ID NO: 8

Species I, drawn to SEQ ID NO: 9

Species J, drawn to SEQ ID NO: 10

Species F-J are patentably distinct based on structural and functional differences and mode of action, as species may target different receptors.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I-V (products) and VI (methods) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group I, may be used for a number of different processes that are very much unrelated. For example, the gene may not only be used in the method of Group VI, but may also be used to make a protein. The method of Group VII may be practiced using various therapeutic agents and do not necessarily have to be used with the products of Groups I-V.

4. The inventions of Groups I-V are structurally and functionally different, are drawn to structurally and functionally different molecules, each invention requires different reagents and steps to make and characterize them, or different methods of use that do not share common steps or reagents and rely on different endpoints.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent subject matter, and require different search strategies, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis, Ph.D.  
June 20, 2001

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600